

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

112740-1043

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Application Number

10/517,935

Filed

March 9, 2005

First Named Inventor

Carsten Krischker

Art Unit

2683

Examiner

Meless Nmn Zewdu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 48,196

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Peter Zura

Typed or printed name

312-807-4208

Telephone number

May 15, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Carsten Krischker
Appl. No.: 10/517,935
Conf. No.: 6885
Filed: March 9, 2005
Title: METHOD FOR IDENTIFYING A TELECOMMUNICATIONS SUBSCRIBER
Art Unit: 2683
Examiner: Meless Nmn Zewdu
Docket No.: 112740-1043

Director of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated February 14, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 22-40 are pending in the present application. Claims 22, 30, 38 and 40 are the focus of this request.

Claims 26, 28, 34 and 36 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22-24, 29-32 and 37-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Yablon* (WO 99/45687) in view of ITU-T Recommendation H.245, sections 5.2-5.9 (XP-002199601). Applicant respectfully traverse this rejection.

Specifically, the cited art, alone or in combination, fails to disclose the feature of "sending device information from the first telecommunications device to the second telecommunications device which indicates a type of subscriber data that the first telecommunication device wants to receive" as recited in independent claim 22 and similarly recited in independent claims 30, 38 and 40.

As an initial matter, the Response to Arguments contained in the Final rejection indicated that the word "wants" is (1) a non-inventive word, and (2) is a subjective word that is attributable to feelings (see pages 11-12 of Final Office Action). Applicant respectfully disagrees with this position. It is well-known that "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) (MPEP 2111.01). Furthermore, an applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its

ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (*Id.*).

The present disclosure provides an exemplary context in which device information indicates a type of subscriber data that the first telecommunications device wants to receive. As is argued below, there is a difference between the general concept of receiving data according to the capabilities of a device, and the ability to control the types of data within the device's capabilities that the user wants to receive. For example, page 14, lines 2-16 provides the following:

[A]fter selecting the appropriate communication partner, in this case Recipient E, the device information GI2 to be sent to the Recipient E is adapted. Where available, the historical data in the form of a version number (here version number "1") of subscriber data for Recipient E that has already been transferred is taken from the associated transmission information and incorporated into the device information GI2. As can be seen in Figure 3, the device information GI2 contains a version number of the partner, that is the previously transmitted subscriber data for the partner (Recipient E) and a list of optional information which Caller A or his/her telecommunications device can or wants to receive. As such, *where Recipient E is able or wants to send the appropriate subscriber data, he/she should transmit all optional subscriber data* (reason for calling, title, name, first name, company, function, e-mail address, optional text, image) *that is identified by a "1" before the appropriate specific data* ("1" means send; "0" means do not send) *in accordance with the device information GI2.*

Also, on page 14, line 27 - page 15, line 8, discloses the following:

Once Recipient E is known to Caller A, then in the mobile phone MFG1 appropriate device information GI1 can be adapted to Caller A, in which from any existing transmission information of Caller A the version number can be taken from previously transmitted subscriber data and incorporated into the device information GI1. In this case, the version number of the stored transmission information or subscriber data of the partner (of Caller A) has the value "0". *In contrast to the device information GI2, Recipient E has set his/her device information GI1 such that he/she does not want to receive the company, function, e-mail address and optional*

text from Caller A that is shown by a "0" before the appropriate option.

Then, a mobile phone MFG1 of Recipient E transmits in a Step II the set or adapted device information GI1 with a message CONNECT PROP CONFIRM() to the telecommunications network NW that, in turn, forwards the device information GI1 with a message CONNECT PROP CONFIRM() to Caller A.

Thus, the plain meaning of the term “wants” is consistent with Applicant’s disclosure of the term which means that the device may selectively choose items or sub-items within its capabilities for receipt.

Regarding *Yablon*, the reference discloses a "handshake" procedure for establishing a call between a first and a second telecommunications device (FIG. 16; page 23, lines 10 to 21). According to step 1 of FIG. 16, the primary user's device informs the caller's user device about the type of information the primary users device is capable of receiving so that the caller's user device may only transmit the proper information the primary user's device. This configuration comports with the ITU-T Recommendation that teaches that, in order to process appropriately received multimedia signals, a capability set containing the total capability of a terminal to receive and decode various signals is made known to other terminal.

However, the above systems do not teach or suggest to send device information from one telecommunication device to another indicating a type of subscriber data that the first telecommunications device wants to receive. Under the aforementioned systems, none of the subscribers assigned to one of the terminals or telecommunications devices can determine which information a user wants to receive respective of other subscriber. As an example, when transmitting multimedia data (e.g., video) during a call set-up process, a subscriber will receive such data, regardless of the fact that the subscriber did not want to receive the data in the first place. Under *Yablon* and the ITU recommendation, the terminal communicates to another terminal or telecommunications device that it is able to receive video data, but nothing is provided for the management and blocking of the data (i.e., selecting types of data the device/user wants to receive). In the case of devices that are limited by processing and/or

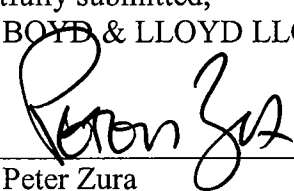
electrical power, such unwanted reception of video data would needlessly consume processing capability and lead to unnecessary consumption of energy.

Furthermore, *Yablon* is silent regarding minimizing the data flow between two terminals or telecommunications devices, particularly in light of FIG. 16, where the exchanging of device information (see step 2, page 23, lines 15 to 18), results in video data being transmitted by one of the telecommunications devices to the other. As a result of not being able to receive such data, a reply message is sent by the receiving telecommunications device to indicate that the information is not capable of being received. This configuration is a not effective way of exchanging device information generating a high data flow, and also teaches away from the recited claims.

In light of the above, Applicant respectfully submits that the rejection under 35 U.S.C. §103 is improper, and Claims 9-16 of the present application are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that the Board overturn the rejection and issue a timely Notice of Allowance in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-1034) on the account statement.

Respectfully submitted,
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Dated: May 15, 2006